

REMARKS

Reconsideration of the application identified in caption in light of the remarks which follow is respectfully requested.

In the Official Action, claim 1 stands provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being obvious over claims 1 and 2 of copending Application No. 10/668,158. Without addressing the propriety of this rejection, and in order to expedite prosecution of the present application, submitted herewith is a Terminal Disclaimer with respect to the '158 application. The filing of such Terminal Disclaimer is effective to overcome the present obviousness-type double patenting rejection. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 1-4 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,143,806 (*Kato et al*). Claims 1 and 2 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0128349 (*Qian et al*).

Withdrawal of the above rejections is respectfully requested for at least the following reasons.

Independent claim 1 is directed to an oil based ink composition for inkjet printer comprising fine particles in a non-aqueous dispersion medium, the fine particles being obtained by melting and kneading a coloring agent and a binder resin, and cooling and pulverizing the resulting mixture to form a colored admixture, and dispersing the colored admixture in the non-aqueous medium, wherein the binder resin comprises a copolymer which is insoluble in the non-aqueous dispersion medium and comprises (a) a monofunctional monomer A containing an aliphatic cyclic hydrocarbon group having from 5 to 30 carbon atoms and (b) a monofunctional monomer B, which is capable of copolymerizing with the monofunctional monomer A and a homopolymer of which is soluble in the non-aqueous dispersion medium.

Kato et al and *Qian et al* do not disclose each feature recited in claim 1, and as such fail to constitute an anticipation of such claim. For example, *Kato et al* and *Qian et al* do not disclose fine particles being obtained by melting and kneading a coloring agent and a binder resin, and cooling and pulverizing the resulting mixture to form a colored admixture, and dispersing the colored admixture in the non-aqueous medium, as recited in claim 1. In this regard, the Patent Office has acknowledged the above-described deficiencies of *Kato et al* and *Qian et al* at page 5 of the Official Action.

Applicants submit that the fine particles obtained in the manner set forth in claim 1, are distinct from the materials employed in the inks disclosed by *Kato et al* and *Qian et al*, as evidenced by the experimental data set forth in the attached Declaration Under 37 C.F.R. §1.132 of Keitaro Aoshima (hereinafter "Declaration"). Applicants further note that the such experimental data shows the surprising and unexpected nature of the claimed oil based ink composition which can be used to form images having improved image durability characteristics.

As set forth in the Declaration, experiments were conducted to compare the image durability characteristics of an image formed using an oil based ink composition comprising fine particles prepared in accordance with an aspect of the claimed invention, with images formed from comparative compositions containing materials prepared in accordance with examples disclosed by *Kato et al* and *Qian et al*. After the images were formed, they were rubbed by finger to observe the durability characteristics thereof.

As discussed in the Declaration, the image formed from the oil based ink composition prepared in the manner set forth at page 42 of the present specification, was not visibly affected by the rubbing. On the other hand, the images formed from the compositions prepared using the oil-based ink (IK-1) of Example 1 of *Kato et al* and the toner of Example

21 of *Qian et al*, were noticeably affected by the rubbing. In view of such experimental results, it is apparent that the fine particles employed in the inventive oil based ink composition, are distinct from the materials disclosed by *Kato et al* and *Qian et al*. Moreover, the experimental results show the surprising and unexpected nature of the claimed invention.

Accordingly, for at least the above reasons, withdrawal of the above anticipation rejections is respectfully requested.

Claim 6 stands rejected under 35 U.S.C. §103(a) as being obvious over *Kato et al* or *Qian et al*, either of which in view of U.S. Patent No. 5,814,685 (*Satake et al*). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Satake et al fails to cure the above-described deficiencies of *Kato et al* and *Qian et al*. In this regard, the Patent Office has relied on *Satake et al* for allegedly disclosing "the use of polymers having average particle size of 20-200 nm and maximum particle size less than 1000 nm in order to prevent clogging of the printer nozzles" (Official Action dated January 18, 2006 at page 10). However, like the other applied art, *Satake et al* fails to disclose or suggest fine particles being obtained by melting and kneading a coloring agent and a binder resin, and cooling and pulverizing the resulting mixture to form a colored admixture, and dispersing the colored admixture in the non-aqueous medium, as recited in claim 1. Accordingly, withdrawal of the obviousness rejection is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited.

If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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